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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 09/988,125 | 11/19/2001 | Richard Montalvo | 6530.0253-00 | 8172 |
| 7590 | 05/05/2004 | | EXAMINER | |
| Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315 | | | DAVIS, DANIEL J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3731 | |
| | | | DATE MAILED: 05/05/2004 | |

15-

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/988,125 | MONTALVO ET AL. |
| | Examiner | Art Unit |
| | D. Jacob Davis | 3731 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-36 is/are pending in the application.
 - 4a) Of the above claim(s) 3,7-11 and 17-20 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4-6,12-16,21-36 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/12/02.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-25 are rejected under 35 U.S.C. 102(b) over U.S. Patent No. 5,810,879 to de Guillebon. Illustrated in Fig. 1, de Guillebon discloses a coil-less tubular member 18, a handle 12, a removably attached externally threaded end effector 16 having a passageway, and a unitary actuator 20. The de Guillebon threads constitute the claimed protrusion.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-6, 12-16, 21-27, 29-32 and 34-36 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,439,478 to Palmer in view of de Guillebon.

Palmer discloses in Figs. 1, 4 and 5 a flexible tubular member 14, a handle 12, an end effector (Fig. 5) comprising hinged biopsy forceps 80 and 82, and wires/unitary actuators 16 and 17. The end effector comprises a passageway through which the wires pass.

Palmer is silent with respect to a releasable attachment portion. De Guillebon teaches a releasable attachment portion comprising threads on the outer wall. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make Palmer's end effector releasably attached to the tubular member, as taught by de Guillebon. Doing so enables the inexpensive interchange of tool tips of various types. Furthermore, tools may be replaced when worn down without having to dispose of the entire instrument (col. 1, lines 11-62). The connection taught by de Guillebon comprises a threads/protrusions on the outer wall of the end effector so that the end effector is attached within the tubular member.

Claims 1, 2, 13-16, 21, 22, 26, 28, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Guillebon in view of U.S. Patent No. 5,931,833 to Silverstein. De Guillebon discloses the limitations of the claims as set forth under 35 U.S.C. 102, but is silent with respect to the rigidity or flexibility of the shaft. Nevertheless, Silverstein teaches that both flexible and rigid shafts are well known in the art (col. 1, lines 23-25). Furthermore, the patent teaches a coil-less flexible shaft 26 connected to the end effector. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the de Guillebon shaft coil-less and

flexible, as taught by Silverstein, to enable the end effector to be manipulated throughout curvatures within the body.

Response to Arguments

Applicants responded to the correct numbering of the elected claims in the Amendment filed February 12, 2004. A signed PTO Form 1449 is attached to this Office action. Applicant's arguments with respect to independent claims 1 and 13 have been considered but are moot in view of the new grounds of rejection.

With respect to the rejections under 35 U.S.C. 103, and particularly claim 13, the de Guillebon device is intended to be used as a laparoscopic device. However, Palmer (col. 1, lines 14-25) and Silverstein (col. 1, lines 41--et seq.) teach that A) the laparoscopic and endoscopic arts overlap such that one of ordinary skill in the art would know to look for teachings in either art, and B) the Palmer and Silverstein devices may be applied to either the laparoscopic or the endoscopic arts.

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (703) 305-1232. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

DJD
April 26, 2004